

REMARKS / ARGUMENTS

The present application includes pending claims 1-25, all of which have been rejected. Claims 2-4, 6, 8-10, 12, 14-16 and 18-25 were objected to as being of improper dependent form. By this Amendment, claims 1-3, 6-9, 12-15, 18-21, and 23-25 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 7-12 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-25 stand rejected under 35 U.S.C.

§ 102(e) as being anticipated by USPP 2004/0034705 ("Focsaneanu"). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. Claim Objections

A. Claims 2-4, 6, 8-10, 12, 14-16 and 18-25 were objected to as being of improper dependent form. The Office Action states the following regarding the objection to claims 2-4, 6, 8-10, 12, 14-16 and 18-25:

With regard to claim 2, claim 1 recites "said at least one access device being separate and distinct from said at least one of a plurality of access points" and "requesting from said at least one of a plurality of access points a status of said at least one access device". Inherently, the step of requesting requires at least one messaging. Therefore, claim 2 reciting "said requesting comprises sending at least one status request", is inherent and does not further limit the subject matter of claim 1. Similarly for claims 8,14,20,24.

Similarly, claim 1 recites "receiving a response from said at least one of a plurality of access points". Inherently, the step of receiving requires at least one messaging. Therefore, claim 3 reciting "receiving [a response] ... at least one status reply message" is inherent and does not further limit the subject matter of claim 1. Similarly for claims 9,15,21,25.

Furthermore, claim 4 recites "said at least one discovery message, said at least one status request message and/or at least one status reply message". Inherently, they are all messages which follow some protocol. Therefore, the term "messaging protocol message" is inherent and does not further limit the subject matter of claim 1. Similarly for claims 10,16,22.

With regard to claim 6, claim 1 recites "broadcasting ... to at least one of a plurality of access points". Claim 6 recites "broadcasting ... only to one or more of said plurality of access points located in a particular subnetwork". Clearly, the plurality of access points can be in one or more networks and/or subnetworks. Therefore, the term "a particular subnetwork" does not further limit the subject matter of claim 1. Similarly for claims 12 and 18.

See Office Action at p. 2-3. The Applicant respectfully traverses the above objections. Nevertheless, to further prosecution, the Applicant has amended claims 1-3, 6-9, 12-15, 18-21, and 23-25, as set forth above, to obviate the objections to claims 2-3, 6, 8-9, 12, 14-15, 18, 20-21, and 24-25. In reference to claims 4, 10, 16, and 22, the Applicant points out that the issue is not whether a certain message will follow a given protocol. Instead, the issue is what is the type of message used when communicating a discovery message, a status request message and/or a status reply message. Since claims 4, 10, 16, and 22 further clarify that the communicated discovery message, status request message and/or status reply message is a specific type of message (e.g., a messaging protocol message), the Applicant submits that these claims are in a proper dependent form.

B. INHERENCY

Based on the above Office Action citation, it appears that claims 2-4, 6, 8-10, 12, 14-16 and 18-25 are being objected based on inherency.

The Applicant submits that a rejection or objection based on inherency must include a statement of the rationale or evidence tending to show inherency. See

Manual of Patent Examining Procedure at § 2112. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” See *id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Applicant respectfully submits that neither the reference provided by the Examiner nor the Office Action “make[s] clear that the missing descriptive matter,” said to be inherent “is necessarily present in” any provided reference.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Applicant respectfully submits that the Office Action does not contain a basis in fact and/or technical reasoning to support the rejection/objection based on inherency.

Instead, as recited above, at least claims 2-4, 6, 8-10, 12, 14-16 and 18-25 of the present application stands rejected based on a conclusory statement of inherency, rather than upon a "basis in fact and/or technical reasoning." Accordingly, the Applicant respectfully submits that, absent a "basis in fact and/or technical reasoning" for the rejection of record, that rejection should be reconsidered and withdrawn.

II. Rejection Under 35 U.S.C. § 101

Claims 7-12 are rejected under 35 U.S.C. § 101 as allegedly not falling within one of the four statutory categories of invention. The Applicant respectfully traverses the rejection. Nevertheless, to further prosecution, the Applicant has amended claim 7 and paragraph 21 of the specification to recite "non-transitory computer-readable medium". The Applicant respectfully submits that the rejection under 35 U.S.C. § 101 should be withdrawn and claims 7-12 are allowable.

REJECTION UNDER 35 U.S.C. § 102

III. Focsaneanu Does Not Anticipate Claims 1-25

The Applicant now turns to the rejection of claims 1-25 under 35 U.S.C. § 102(e) as being anticipated by Focsaneanu. With regard to the anticipation rejections under § 102, MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single

prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

Without conceding that Focsaneanu qualifies as prior art under 35 U.S.C. § 102(e), the Applicant respectfully traverses this rejection as follows.

A. Rejection of Independent Claims 1, 7, 13, 19 and 23 under 35 U.S.C. § 102(e)

With regard to the rejection of independent claim 1 under 35 U.S.C. § 102(e), the Applicant submits that Focsaneanu does not disclose or suggest at least the limitation of "receiving a response from said at least one of said plurality of access points, said response reporting a presence of at least one access device located within a coverage area of said at least one of said plurality of access points, said at least one access device being separate and distinct from said at least one of said plurality of access points," as recited by the Applicant in independent claim 1.

The Office Action states the following:

With regard to claims 1,7,13,19,23, Focsaneanu discloses broadcasting ("interrogates the other address servers", para. [0070]) (See Also "55 Queries All AS's [address servers]" in Fig. 5) at least one discovery message ("query signal", para. [0070]) to at least one of a plurality of access points (e.g. address server 45) (address servers 44,45,46,47 in Fig. 4A and 5, para. [0061]) ("The address server is also provided with network communication capabilities", para. [0063]);

receiving a response ("query response signal", para. [0070]) from said at least one of a plurality of access points (address server 45), said

response reporting a presence of at least one access device (e.g. user U6 in Fig. 4A and 5)("If address server 45 finds UID6 [user U6] in memory 44', it responds to the query", para. [0070]) located within a coverage area of said at least one of a plurality of access points (responding to a query indicates a presence)(See Also US 2004/005859, "respond to the queries to indicate its respective presence", para. [0345] and US 2003/0226033, "a response to the broadcasting node indicating its presence in the unbounded computing space", para. [0037]), said at least one access device (user U6) being separate and distinct from said at least one of a plurality of access points (address server 45); and

requesting from said at least one of a plurality of access points (e.g. address server 47), a status (network address indicates a "connected" status, "not connected", "not allowed") of said at least one access device (e.g. user U4) located within said coverage area of said at least one of a plurality of access points (e.g. if an address server have a network address of a user, the query response includes the network address. If an address server does not have a network address for user U4, the query response is "not connected") ("However, address server 47 does not have a network address for user since device is not connected to the network. Address server responds to the query by sending a "not connected" message", para. [0071]) (See Also "not allowed" , para. [0075]).

See Office Action at pages 4-5. Initially, the Applicant points out that the Office Action is inconsistent in specifying exactly which module of Focsaneanu is being equated to Applicant's "at least one of a plurality of access points". For example, the Office Action (p. 4) seems to equate Applicant's "at least one of a plurality of access points" to any of the address servers 44, 45, 46 or 47. However, the "receiving" limitation seems to use address server 45, and the "requesting" limitation seems to use address server 47. Therefore, the Applicant submits that the Office Action is deficient since it is inconsistent and utilizes different address servers to perform functionality being performed by the same "at least one of a plurality of access points".

Additionally, the Applicant points out that an “access point” is a specific term of art, and Focsaneanu's servers 44-47 are simply storage servers, without the ability to connect one or more devices to a network. The Applicant submits that Focsaneanu is distinguished at least based on this reason alone.

With regard to Applicant's “receiving” limitation, the Office Action equates Applicant's “at least one of a plurality of access points” to address server 45. Additionally, the Office Action equates Applicant's “response from said at least one of said plurality of access points” to Focsaneanu's “query response signal” at step 57. Referring to Focsaneanu's Fig. 5, the query response signal 57 is in response to the query signal 55. The query signal 55 is a request for specific user (U6) address information. The query response signal 57 then simply provides the U6 address information to the address server 44. In this regard, the query response signal 57 is not related to a “coverage area” of the address server 45, and, therefore, cannot report a presence of an access device within such coverage area. Again, not only is the access server 45 not an access point, but the access server 45 is not characterized by a specific coverage area and, therefore, there can be no “reporting a presence of at least one access device located within a coverage area of said at least one of said plurality of access points...,” as recited in Applicant's claim 1.

Accordingly, independent claim 1 is not anticipated by Focsaneanu and is allowable. Independent claims 7, 13, 19 and 23 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that

independent claims 7, 13, 19 and 23 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-6, 8-12, 14-18, 20-22 and 24-25

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 7, 13, 19 and 23 under 35 U.S.C. § 102(e) as being anticipated by Focsaneanu has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-6, 8-12, 14-18, 20-22 and 24-25 depend from independent claims 1, 7, 13, 19 and 23, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-6, 8-12, 14-18, 20-22 and 24-25.

In general, the Office Action makes various statements regarding claims 1-25 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-25 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 26-AUG-2010

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